

No. 3004

IN THE

**United States Circuit Court of Appeals**

**For the Ninth Circuit**

---

SIMPLEX WINDOW COMPANY,

*Appellant,*

VS.

HAUSER REVERSIBLE WINDOW COMPANY, et al.,

*Appellees.*

**BRIEF FOR APPELLANT.**

---

JOHN H. MILLER,

*Attorney for Appellant.*

**Filed**

OCT 6 - 1917



No. 3004

IN THE

# United States Circuit Court of Appeals

For the Ninth Circuit

---

SIMPLEX WINDOW COMPANY,

*Appellant,*

VS.

HAUSER REVERSIBLE WINDOW COMPANY, et al.,

*Appellees.*

---

## BRIEF FOR APPELLANT.

---

### Statement of Facts.

This is an appeal from a final decree in a patent case rendered in favor of the defendants.

Plaintiff below, appellant here, was the Simplex Window Company, a corporation, and the defendants were Hauser Reversible Window Company, a corporation, Frederick and Jessie Hauser.

Two patents were sued on, one No. 1,159,604 of November 9, 1915, issued to the plaintiff as the assignee of the inventors Arthur C. Soule and Louis A. Larsen; and the other No. 1,072,669, issued September 9, 1913, to the plaintiff as the assignee of the inventor Arthur C. Soule.

On this appeal we have concluded to eliminate the first named (Soule & Larsen) patent and to confine ourselves to the second (Soule) patent. In other words, we accept the decision of the lower court in respect of the Soule and Larsen patent and ask a reversal of the decree only in respect of the Soule patent, No. 1,072,669. This will simplify the issues and present for consideration the single question, does the structure of the defendants infringe upon the Soule patent, No. 1,072,669?

The defendants operate under letters patent No. 1,114,260, issued October 20, 1914, to defendant Frederick Hauser, and the question of infringement may be determined from a comparison of the drawings of the Hauser patent with the claims of the Soule patent.

Plaintiff's patent, marked "Plaintiff's Exhibit No. 2, Soule patent", appears between pages 94 and 99 of the record.

A model of plaintiff's device was put in evidence, marked "Plaintiff's Exhibit No. 4, Model of Soule patent" (Rec. 19).

The Hauser patent, which shows the infringing structure, was marked "Defendant's Exhibit A", and appears between pages 100 and 103 of the record.

A model of the Hauser device, marked "Plaintiff's Exhibit No. 5, Defendant's structure", was put in evidence (Rec. 19) by plaintiff.

Also another model was put in evidence by plaintiff, marked "Plaintiff's Exhibit No. 6", being a combined model showing on one side the specific structure of the plaintiff's patent and on the other side the structure of the defendants.

Baldwin Vale, Esq., testified for the plaintiff as an expert witness, and Arthur C. Soule gave testimony regarding the commercial operations of plaintiff.

The only witnesses for the defendants were Frederick Hauser, one of the defendants, and Fred Behnke.

The case was tried before Judge Frank H. Rudkin, sitting in the Northern District of California, and his opinion appears at page 16 of the record. It reads as follows:

"A careful examination of the testimony, exhibits and briefs in this case has failed to convince me that the charge of infringement has been made out. The bill of complaint must therefore be dismissed. Ordered decree be entered accordingly."

In accordance with that decision a decree was rendered dismissing the bill and awarding costs to defendants (Rec. 17-18).

A statement of the evidence on appeal was prepared and the case comes to this court upon the said statement (Rec. 18-67).

The original exhibits were withdrawn from the custody of the lower court and are now here for examination.

---

#### PLAINTIFF'S PATENT.

There are eight claims included in the plaintiff's patent, but only claims 1, 4 and 7 are charged to be infringed. Those claims read as follows:

1. A window comprising a frame, a sash slidably pivoted in said frame, adjuster arms, one end of which being fixedly pivoted at points slightly above the middle of the sash stiles, and the other end slidably pivoted in the frame, and carrier arms one end of which is fixedly pivoted in the frame and the other end fixedly pivoted to the corresponding adjuster arm.

4. A window comprising a frame, a sash in said frame, an adjuster arm pivotally secured at one end to said frame and at the other end to said sash, and a carrier arm pivotally secured at one end to said frame and at the other end to said adjuster arm.

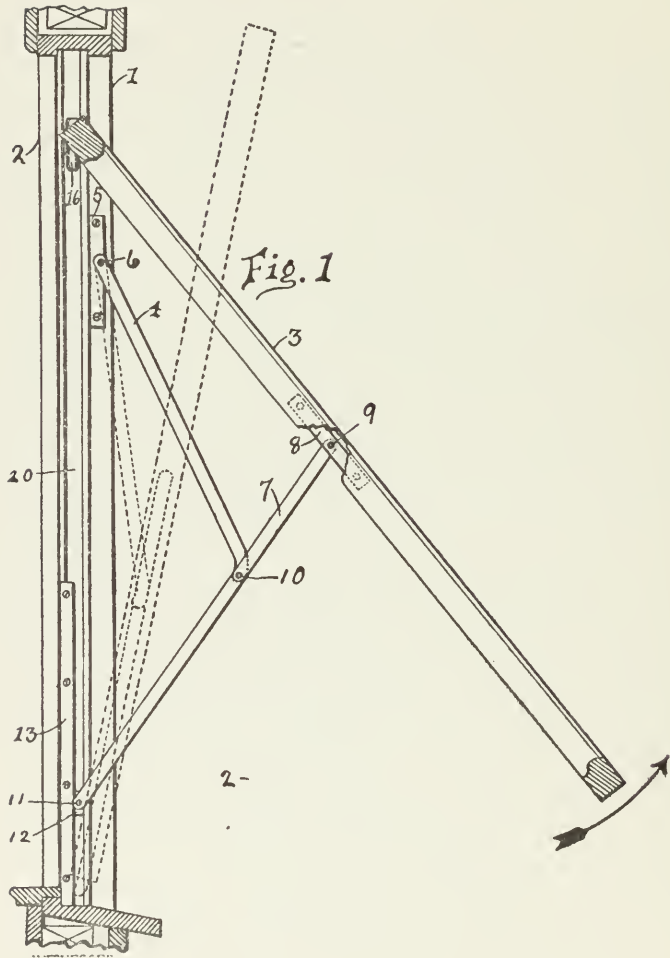
7. A reversible window comprising a sash, an adjuster arm of suitable length, a carrier arm supporting said adjuster arm and window sash, a slidable pivoted connection between said frame and one end of said adjuster arm, and a pivoted connection between the other end of said adjuster arm at points near the middle of the sashstiles, about which said sash is rotatable.

On the adjoining page is a reproduction of Fig. 1 of plaintiff's patent, from which the construction of the device will be clearly seen. The invention relates particularly to windows of the swinging reversible sash type, and has for its object the provision of an arrangement which will allow the window to remain in stable equilibrium against wind strains in whatever position it may be placed and to be readily removed from one position to another when desired. Another feature is that the sash is reversible in the frame for the purpose of washing.

Referring to the drawing, which is a side elevation, the numeral 1 represents the window jamb, 2 the stop, and 3 the sash. In the drawing the sash has been represented as moved outward so as to open the window. The numeral 20 represents a groove in the side of the window frame and 16 represents a shoe or block slidable up and down in said groove. To the shoe 16 the sash is pivoted at its upper end so as to rotate on that pivot in its opened and closed position. The details of this pivoting are represented by Fig. 6 of the patent, but it will not be necessary to examine such details. It is sufficient to say that by the structure the sash is slidably pivoted in the frame.

In order to hold the sash in stable equilibrium at any desired point against wind strains, the following mechanism is provided. The numeral 7 designates in the patent an *adjuster arm*, which is fixedly pivoted at its outer end to the sash near the

FIG. 1 OF SOULE PATENT. No 1,072,669.





middle thereof, about two inches above the middle. This pivot is designated by the numeral 9. The other, or inner end of this adjuster arm, is pivoted by the pin 11 to a sliding block or fixture 12 located in the groove 20 at the lower end of the frame and adapted to move up and down in said groove. When the window is closed, the fixture 12, carrying the inner end of the adjuster arm, will be located at the bottom of the groove, and when the sash is moved outward, this fixture 12 will move upward in the groove in the position shown in the drawing.

The particular details of this sliding fixture are shown in Figs. 4, 5 and 7, but they are of no material consequence here.

In addition to the above, and for the purposes of securing the general equilibrium desired and for allowing the window to be readily shifted from one position to the other, there is provided another arm, called a *carrier arm*, designated by the numeral 4. One end of this arm is pivoted to the adjuster arm 7, by a pivot 10, at a point about one-third the length of the adjuster arm measured from the pivot 9, while the other end of this carrier arm 4 is pivoted to the window frame by means of the pin 6 in a wearing plate 5 which is set in the jamb by screws. It is preferable that the lower part of this carrier arm 4 should be curved, but this curving is not essential and is not called for by the claims.

The mode of operation of the device will be as follows: Assuming that the window is closed and it is desired to open it and hold it open at any particular point, the operator pushes outward against the lower end of the sash 3, which moves or tilts. it outward in the direction shown by the arrow, causing the sliding block 12, to which the lower end of the adjuster arm 7 is attached, to move upward in the groove of the window frame, and the sash will assume the position shown in the drawing. It is evident that the sash will be held open at any desired point against wind strains. When it is desired to close the window, the sash is moved back into the initial position by pulling the lower end of the sash inward, the sliding block 12 moving down to the bottom of the groove and the arms 4 and 7 folding up like a jack knife. It is apparent that the sash is reversible in the window frame.

We shall now consider briefly the claims in suit, and as claim 4 appears to be the broadest one, we shall take that as the first in order. It reads as follows:

*Claim 4.*

“A window comprising a frame, a sash in said frame, an adjuster arm pivotally secured at one end to said frame and at the other end to said sash, and a carrier arm pivotally secured at one end to said frame and at the other to said adjuster arm.”

This is a combination claim consisting of the following elements: (1) a frame; (2) a sash; (3) an adjuster arm pivotally secured at one end to the frame and at the other end to the sash, and (4) a carrier arm pivotally secured at one end to the frame and at the other end to the adjuster arm.

Referring to the device by the numerals shown on the drawing this is a combination of 1 plus 3, plus 7, plus 4, that is to say, a frame, a sash, an adjuster arm, and a carrier arm.

*Claim 7.*

“A reversible window comprising a sash, an adjuster arm of suitable length, a carrier arm supporting said adjuster arm and window sash, a slidable pivoted connection between said frame and one end of said adjuster arm, and a pivoted connection between the other end of said adjuster arm and points near the middle of the sash-stiles, about which said sash is rotatable.”

This is a combination of the following elements: (1) a sash; (2) an adjuster arm; (3) a carrier arm supporting the adjuster arm and the sash; (4) a slidable pivoted connection between the frame and one end of the adjuster arm; (5) a pivoted connection between the other end of the adjuster arm at a point near the middle of the sash about which the sash is rotated. And the claim is further characterized by the attribute of reversibility of the sash.

*Claim 1.*

“A window comprising a frame, a sash slidably pivoted in said frame, adjuster arms, one

end of which being fixedly pivoted at points slightly above the middle of the sash-stiles, and the other end slidably pivoted in the frame, and carrier arms one end of which is fixedly pivoted in the frame and the other end fixedly pivoted to the corresponding adjuster arm."

This is a combination of the following elements: (1) a frame; (2) a sash slidably pivoted in the frame; (3) adjuster arms having one end fixedly pivoted at points slightly above the middle of the sash and the other end slidably pivoted in the frame; (4) carrier arms having one end fixedly pivoted to the frame and the other end fixedly pivoted to the adjuster arm.

This claim 1 takes in both sides of the window, whereas the other two claims take in only one side. It is to be remembered that in the structure of the patent there is an adjuster arm on each side of the window, and there is a carrier arm attached to each of the adjuster arms, thereby providing two adjuster arms and two carrier arms. This claim 1 calls for the two adjuster arms and the two carrier arms in a complete structure, whereas the other two claims call for only one adjuster arm and one carrier arm.

These three claims are framed in clear language and there does not appear to be any ambiguity regarding the elements. No anticipations are set up, nor is the validity of the claims challenged. We think, therefore, that we are safe in assuming that these claims must be considered as broad and com-

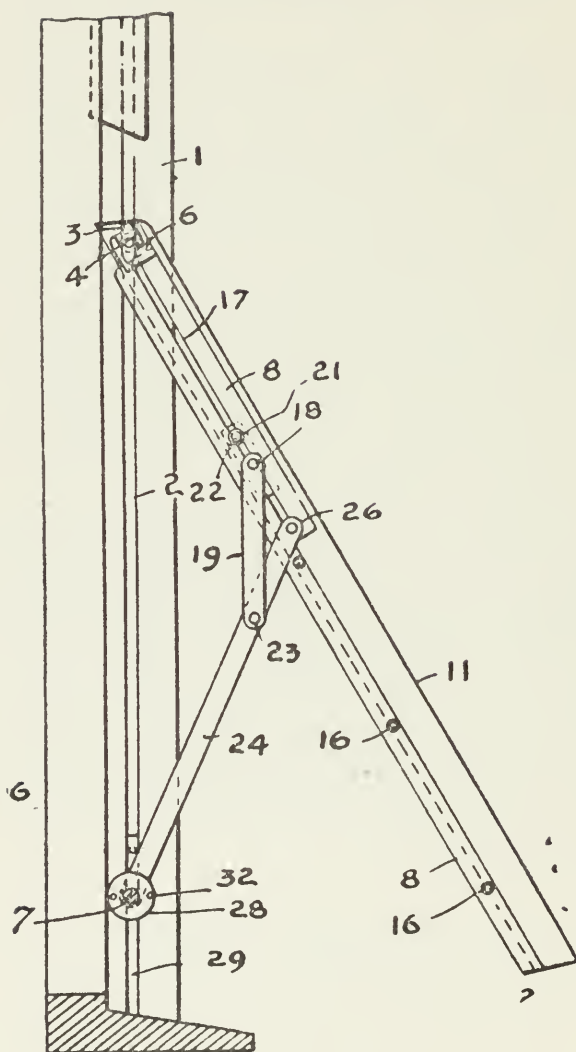
prehensive claims. We assert that the patent is the first of its kind in the art and shows a pioneer invention. Had it been otherwise, anticipating structures would have been shown. The only prior patented structure which was shown, but for what purpose passes our comprehension, is a patent to Frotscher, No. 509,521, of November 28, 1893, appearing between pages 104 and 108 of the record. It is also shown by "Defendant's Model Exhibit B".

It is a wholly different structure from anything shown in our patent and has no relevancy except as showing a useless and impracticable device. The defendant Frederick Hauser testified to that effect. At page 53 of the record we find him saying in regard to the Frotscher patent:

"I never made any windows like that; I didn't want to make them like that; they are useless; I found out they are useless with windows made that way, so I got up my own idea which is a useful device; the other one is not a practical or a useful device; I say it is not a useful device; no, you can not use it, but I would like to explain it a little better; you can use it, but it is, in other words, not practicable, not a practicable device; they do not use it at all any more."

In further support of our contention regarding the utility and pioneership of the Soule patent we refer to the testimony of Mr. Soule on page 42, et seq., where he says that the plaintiff has put the invention on the market with great success throughout the Pacific Coast and the Eastern States to the

FIG. 2 OF HAUSER PATENT. No. 1,114,260.



extent of selling over 150,000. The device is extensively used in Washington, Oregon, California, Arizona, Texas, New York, Georgia, Florida, Louisiana, Illinois, Minnesota, Ohio and Pennsylvania (Rec. 43).

In view of the record and in the absence of any thing shown to the contrary, we assert that the Soule invention is of a broad and pioneer character and entitled to a liberal application of the doctrine of equivalents.

---

#### DEFENDANTS' STRUCTURE.

Defendants' structure is shown by the model marked "Plaintiff's Exhibit No. 5, Defendants' Structure" and also by the Hauser patent, No. 1,114,260, of October 20, 1914. On the adjoining page is reproduced Fig. 2 of that patent, which is a vertical section showing the sash open. The numeral 1 represents the side frame and 2 the groove therein running from top to bottom. In this groove 2 a metal block 3 is adapted to slide up and down. To this metal block is pivoted the upper end of the sash 11. The numeral 24 represents an adjuster arm pivoted at its lower end to a stationary block in the groove of the window frame and at the upper end it is pivoted to the window sash at a point 26 slightly beyond the center, which is the point where Soule pivots his adjuster arm. To this adjuster arm at the point 23, which is the point at



which Soule attaches his carrier arm, is pivoted a carrier arm 19 (called in the Hauser patent a *link*); while the upper end of this carrier arm or link is pivoted to a sliding mechanism located in a groove in the window frame.

The operation of the mechanism is apparent. Assuming the window to be closed and it is desired to open the same, the operator pushes on the lower end of the sash outwardly, which causes the upper end of the sash to move downward in the groove in the window frame, while the adjuster arm and carrier arm move outwardly and assume the positions shown in the drawing. When it is desired to close the window, the sash is moved in the reverse direction, thus causing the upper end of the sash to move upward in the groove in the frame and the carrier arm 19 to slide upward in the groove in the sash, both arms folding up like a jack knife. It is apparent that the sash is reversible in the frame as in the Soule structure.

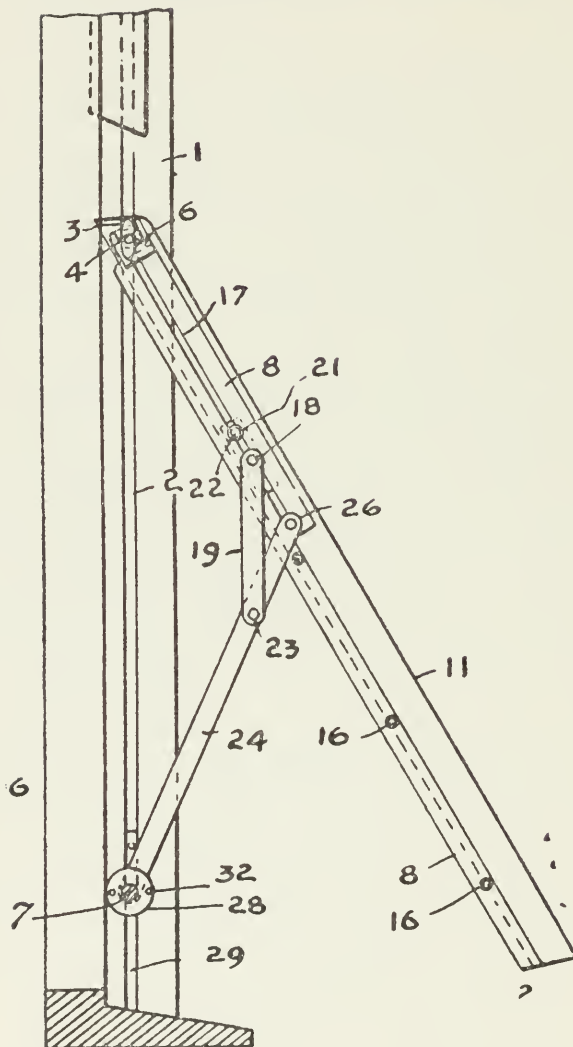
Comparing this mechanism with the drawing of the Soule patent it will be seen that the only difference in construction is that in the Soule device the upper end of the carrier arm 4 is *fixedly* pivoted to the window *frame*, whereas in the Hauser construction the upper end of the carrier arm is *slidably* pivoted to the window *sash*, and also in the Soule device the lower end of the adjuster arm 7 is *slidably* pivoted to the frame, whereas in Hauser that attachment is a *fixed* one. In order to com-



compensate for this change Hauser has located his sliding mechanism in the window frame. To make it a little clearer, Hauser has removed the inner end of Soule's carrier arm 4 from its point of attachment in the window frame and transposed it to the window sash. This new location required that the attachment be a slidable one. If it were not slidable, but was fixed, then the sash would be held in a permanent fixed position and could not be moved at all, because the construction would in such event be that of a truss. Hence he made it slidable in a groove.

But no new result is obtained by this transposition nor any new mode of operation. Identically the same result is attained in both instances by the same mode of operation. All the elements are necessary to successfully operate in each case, and it is merely a change of location of one particular element. The elements are window frame, sash, adjuster arm, carrier arm, and sliding mechanism. Hauser has all those elements. It is absolutely necessary for him to have all those elements. Otherwise his window would not operate. This reduces the controversy to the single point that a change in the position of one of the parts of a machine does not avert infringement where the part transposed performs the same function after the change as before unattended by any change in mode of operation.

FIG. 2 OF HAUSER PATENT. No. 1,114,260.



COMPARISON OF THE HAUSER DEVICE WITH THE  
SOULE CLAIMS.

Now permit us to compare the Hauser structure with the Soule claims, element for element, taking up claim 4 first.

The elements of claim 4 are (1) a frame; (2) a sash located in the frame; (3) an adjuster arm pivotally secured at one end to the frame and at the other end to the sash; and (4) a carrier arm pivotally secured at one end to the frame and at the other end to the adjuster arm.

Referring now to the drawing of the Hauser device reproduced on the opposite page, we find that it contains a frame, designated by the numeral 1; a sash located in the frame, designated by the numeral 11; an adjuster arm, designated by the numeral 24, which is secured at one end to the window frame and at the other end to the window sash; and finally, it has a carrier arm, designated by the numeral 19, pivotally secured at one end to the adjuster arm and pivotally secured at the other end to the sash.

In the Soule structure this carrier arm is pivotally secured at the upper end to the window *frame*, whereas in the Hauser structure, the pivotal attachment of the carrier arm at its upper end, is to the window *sash*. In other words, the sole and only difference between the two structures is that in the Soule structure one end of the carrier arm is attached to the *frame*, while in the Hauser struc-

ture that end of the carrier arm is attached to the *sash*.

This is merely a change in the location of one of the elements of the combination. But this change in location effects no different result. On the contrary, it produces identically the same result. In the Hauser structure when the sash is moved outward or inward, the pivoted end of the carrier arm 19 slides up and down in a groove in the sash and the various pivoted parts open and close like a jack knife. In the Soule structure the lower end of the adjuster arm slides up and down in a groove in the window frame and the connected pivoted parts open and close like a jack knife. As stated before, the only change made is one of location as to the point of attachment of one of the elements without introducing in the structure any new mode of operation or accomplishing any different result.

Now consider claim 7 of the Soule patent. That claim contains as elements (1) a sash; (2) an adjuster arm; (3) a carrier arm supporting the adjuster arm and the sash; (4) a slidable pivoted connection between the frame and one end of the adjuster arm, and (5) a pivoted connection between the other end of the adjuster arm at a point near the middle of the sash about which the sash is rotatable.

The only point to consider in respect of this claim is element 4, which calls for a *slidable* pivotal

connection between the frame and one end of the adjuster arm. That slidable pivotal connection is shown in the drawing of the Soule patent to consist of a block 12, to which the lower end of the adjuster arm is attached, and this block slides up and down in the groove in the window frame. Now in the Hauser structure the lower end of the adjuster arm does not slide in the groove of the window frame, but is *fixedly* pivoted there, and in order to compensate for this the sliding mechanism has been transferred to a groove in the window sash, in which the end of the carrier arm slides. Here again we find a mere change of location without any change in result or mode of operation. Hence the change of location is inconsequential and the two structures are mechanical equivalents.

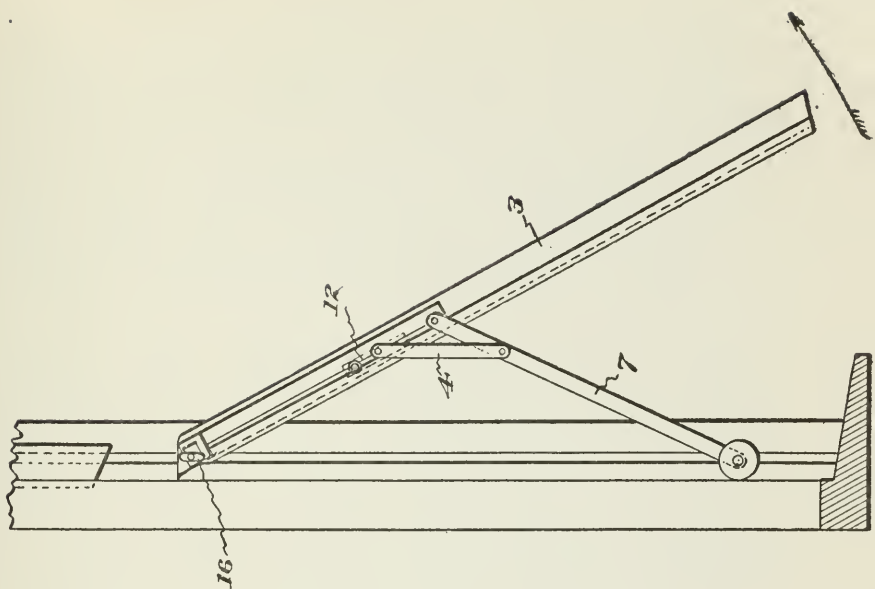
The elements of claim 1 are (1) a window frame; (2) a sash slidably pivoted in the frame; (3) adjuster arms having one end fixedly pivoted at points slightly above the middle of the sash and the other end slidably pivoted in the frame, and (4) carrier arms having one end fixedly pivoted to the frame and the other end fixedly pivoted to the adjuster arm.

From what has already been said it will be seen that the only difference between the language of this combination and the Hauser structure is that whereas in the Soule structure the lower end of the adjuster arm is *slidably* pivoted to the frame and the outer end of the carrier arm is *fixedly* pivoted

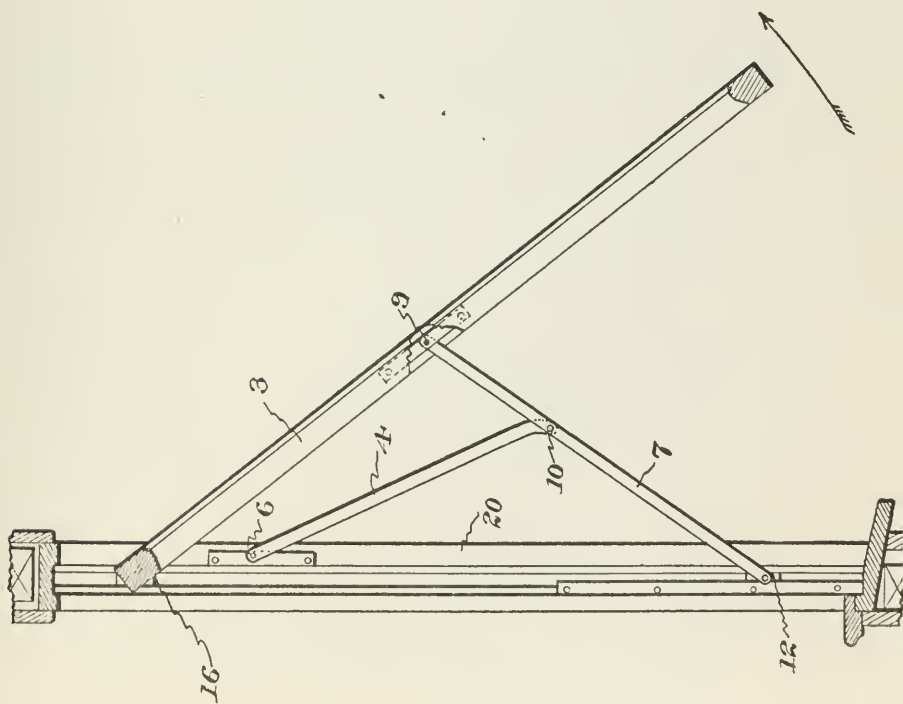
to the *frame*, in the Hauser structure the lower end of the adjuster arm is *fixedly* pivoted to the frame and the upper end of the carrier arm is *slidably* pivoted to the *sash*. Here again we have merely a change of location without any change of mode of operation or the result effected. We submit that the mere changes in detail above noted are, from a patent point of view, inconsequential, and that the Hauser structure is a mechanical equivalent of the Soule structure in so far as the three claims in question are concerned.

In order that the court may have a clear conception of the matter at a glance, we have reproduced on the adjoining page two cuts, one showing the Soule structure and the other showing the Hauser structure. The lettering used is taken from the Soule patent and applied to both diagrams. It will be seen from these two diagrams that all of the elements of the Soule claims have been utilized in the Hauser structure, and that the sole and only difference is a change of location of one of the elements by Hauser. He has merely changed the pivoting of the upper end of Soule's carrier arm from the window frame and located it in the window sash and made it slidable in the sash. No different result is produced nor any different mode of operation.

HAUSER



SOULE





### Law of the Case.

At Sec. 348 of *Walker on Patents*, the law applicable to this case is stated in the following words:

“Changing the relative positions of the parts of a machine or manufacture does not avert infringement, where the parts transposed perform the same respective functions after the change as before.”

This is a very ancient rule of law. The first reported case involving it is *Potter v. Schenck*, 3 Fish. 82, also reported in 19 Fed. Cas. 1182. The patent involved was one of the early sewing machine patents, issued in 1856, and the claim called for a feeding apparatus placed *underneath* the plate upon which the cloth rested. The defendant had used these same elements, but had placed the feeding apparatus *above* the plate, thus presenting the case of a change of location. No new result was produced by the change nor any difference in the mode of operation. Judge Drummond, in referring to the infringing device, used this language:

“The shoe or main part of the feeding apparatus, is not placed beneath the plate upon which the cloth rests, but is on the top of the plate, or, as was contended, and I think with a good deal of force, by the counsel for the complainants, instead of being placed as Wilson describes it, it was merely reversed. It is clear that that does not change the principle of the invention, and it is clear, too, as already stated, that a mechanic once having the idea in his mind could apply it by adopting a great variety of forms and devices, and this among others.”



The next reported case on the subject is that of *Adams v. Joliet Mfg. Co.*, 1 Fed. Cas. 123. There the invention was a "beater-shaft" used in a corn-sheller for the purpose of forcing the ears of corn into the throat of the sheller. In the patent this beater was claimed as being located in a certain position, whereas the defendant had changed its location to a different position. No new result, however, was accomplished by this change of location, nor was any new function performed by the changed member. The court said:

"A change of location of a part in a combination, where there is no new function performed by the changed member in its new location, will not evade a patent."

And in support of this rule of law the court cited the prior case of *Potter v. Schenck*.

Another case in point is that of *Knox v. Great Western Quick-Silver Co.*, 14 Fed. Cas. 810, where the outlet vapor-flue of a quicksilver furnace was transferred by the defendant from the position shown in the patent to a different position. That case was in this circuit, and Judge Sawyer decreed an infringement. Referring to defendant's device, he said:

"It is substantially the same combination of the same parts, and the same number of parts, all operating in substantially the same way and producing the same results, the only change being in the place of the outlet vapor-flue."

He then proceeded to quote from the case of *Adams v. Joliet Mfg. Co.*, as follows:

“A change of location of a part, in a combination, where there is no new function performed by the changed member in its new location, will not evade a patent.”

And after making said quotation he applied it to the case before him as follows:

“In this case the changed part—if, in the view suggested, there can be said to be a change—performs no new function. It operates in precisely the same way and accomplishes the same result in the same mode in the combination.”

In *Schlicht v. Chicago Sewing Machine Co.*, 36 Fed. Rep. 585, the invention was a letter-file, which called for the combination of *rocking* transfer wires with *fixed* receiving wires. The defendant reversed these positions by making the transfer wires *fixed* and the receiving wires *rocking*. This was held to be ineffectual, and infringement was decreed. The court said:

“This seems to me to be merely a colorable change in the construction of the device; the transfer of the function of movement from the vibrating wires to the receiving wires is merely such a change as, with the complainant’s patent before him, any mechanic might readily make, and is but an attempt at an evasion of the idea covered by the complainant’s patent.”

Another pertinent case is *Consolidated Roller Mill Co. v. Coombs*, 39 Fed. 25, where the court said (pages 33-4):

“The change of the location of an element in a combination, where there is no new function performed by such element in its new location, will not evade the charge of infringement.”

A still more pertinent case is that of *Metallic Extraction Co. v. Brown*, 104 Fed. 352. The claim there involved related to an ore-roasting furnace, and it called for a combination in which one of the elements was stated to be a supplemental chamber *located at the side of the main chamber*. The defendant had transferred this supplemental chamber to the *bottom* of the main chamber. In other words, he simply changed the location of that element without producing any new result, and the court held that it was clearly an infringement for the reason that a mere change of location unattended by a new result does not evade infringement. In deciding the case, the court relied largely upon the cases of *Winans v. Denmead*, 14 How. 330, and *Hoyt v. Horne*, 145 U. S. 302.

In the *Winans* case the patentee had claimed a car body made *in the form of the frustrum of a cone*, whereas the defendant had used a car body made *in the form of the frustrum of a pyramid*. The same result was produced, however, in each case by the same principle of operation, and notwithstanding the specific language of the claim the Supreme Court held that the pyramidal form was an infringement of the conical form.

In the case of *Hoyt v. Horne* cited, the patent covered a machine for beating rags and other

fibrous material into pulp, and in his claim the patentee had described his improvement as consisting in circulating the fibrous material and liquid *in vertical planes*. By making slight changes of location in certain parts of the machine described by the patent, the defendant produced a device which caused the pulp to circulate *in a horizontal plane* instead of in a vertical plane. This change of circulating planes followed from the change of location of certain parts of the machine. The Supreme Court held this change to be ineffectual and decreed an infringement.

*Rodebaugh v. Jackson*, 37 Fed. 882 (886), is a case where the difference between pivoting a rod at the *bottom* and the *top* was held to be immaterial in the sense of the patent law. At page 886 the court said:

“\* \* \* and it is entirely clear to our mind that the defendants device differs from that of Rodebaugh only in the rearrangement of the combination, by which a connecting rod, operating by a thrust and articulating with the movable shaft at the bottom, is substituted for the connecting strap F, operating by tension and articulating with the reciprocating shaft at the top by means of the arm G. In this particular the case is much like that of *Ives v. Hamilton*, 92 U. S. 426.”

Strictly in point is *B. F. Avery & Sons v. J. I. Case Plow Works*, 148 Fed. 219-20, where the difference between the infringing device and the patent

was in the location of one of the parts of the combination. The court said (page 220):

“Here the result is obtained quite irrespective of the location of the upper ends of the brace-rods. Appellants reach the result by one location of the material element; appellee by another location equally well known, and the state of the art does not require the novelty of the claims to be predicated on a particular location.”

The true rule of construction deducible from the authorities and applicable to this case is found in the case of *Benbow-Brammer Mfg. Co. v. Simpson Mfg. Co.*, 132 Fed. 614. There the claim of the patent contained a specifically described element, to wit: “a double row” of teeth. The defendant had used “a single row” of teeth. But the court held that the two were mechanical equivalents, and notwithstanding this specific designation of the element in the claim, infringement was found. The rule is there stated as follows:

“The specific description in the claim of an element does not operate as a limitation to the form thus shown, unless it is of the essence of the invention, and evasion of the specified form will not escape infringement, where the substance of the invention is copied.”

In support of this rule the court cited the cases of *Ives v. Hamilton*, 92 U. S. 426; *Machine Co. v. Murphy*, 97 U. S. 120; *Hoyt v. Horne*, 145 U. S. 302; and sundry cases from the various circuit courts of appeal throughout the United States.

Another case in point is that of *Columbia Wire Co. v. Kokomo Steel & Wire Co.*, 143 Fed. 122, where the Court of Appeals for the Seventh Circuit considered the case of a mere transposition of parts, and at page 122 we read the following:

“We are of the opinion that the means thus transposed in the appellee’s machine, if not within the definition of colorable evasions which infringe the patent in any view of its scope, are plain appropriations of the essence of the Bates conception by equivalent means, and infringements of the patent within the well settled rule referred to. All the elements of the patented combination are employed with substantial identity in their use, and departure appears from the letter of the claims only, in the arrangement of these elements, without substantial difference in the principle of operation. The policy and rules of the patent law require that the patentee be protected against such evasions of the wording of a claim in form or non-essential details, when the substance of the invention is thus used and is unmistakably shown in the specifications and claims.”

At this point it may not be out of place to refer to the case of *Machine Co. v. Murphy*, 97 U. S. 120, where the Supreme Court laid down the doctrine of equivalency. It is there said:

“Except where form is of the essence of the invention it has little weight in the decision of such an issue, the correct rule being that, in determining the question of infringement, the court or jury, as the case may be, are not to judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of what they do, or what office or function



they perform, and how they perform it, and to find that one thing is substantially the same as another, if it performs substantially the same function in substantially the same way to obtain the same result, always bearing in mind that devices in a patented machine are different in the sense of the patent law when they perform different functions or in a different way, or produce a substantially different result. Nor is it safe to give much heed to the fact that the corresponding device in two machines organized to accomplish the same result is different in shape or form the one from the other, as it is necessary in every such investigation to look at the mode of operation or the way the device works, and at the result, as well as at the means by which the result is attained.

\* \* \*

“Authorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself; so that if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape.”

In applying the doctrine of this citation, this court, through Judge Gilbert, uses the following language in the case of *American Can Company v. Hickmott*, 142 Fed. 141:

“It is the whole purpose of the doctrine of equivalency to protect the inventor against piracy and to secure to him the benefit of that which he has invented.”

Along the same line we venture to cite another decision of this court, *Norton v. Jensen*, 49 Fed. 859, where the court, through Judge Hawley, expressed itself as follows:

“No one can avoid infringement simply by means of ingenious diversities of form and proportion, presenting simply the appearance of something unlike the patented machine. It is well settled that a copy of the principle or mode of operation described in the prior patent is an infringement of it. If the patentee’s ideas are found in the construction and arrangement of the subsequent device, no matter what may be its form, shape, or appearance, the parties making or using it are deemed appropriators of the patented invention, and are infringers. An infringement takes place whenever a party avails himself of the invention of the patentee without such a variation as constitutes a new discovery.

“Judge Nelson in *Blanchard v. Beers*, 2 Blatchf. 416, said that—

“‘The sure test and one the jury should be guided by in all cases of this kind, is whether or not the defendant’s machine, whatever may be its form or mechanical construction, has incorporated within it the principle, or the combination, or the novel ideas which constitute the improvement to be found in the plaintiff’s machine. If it does, then, no matter what may be its mechanical construction or its form, it is an infringement, an appropriation of the ideas of another, simply in a different form.’

“The same learned judge in *Tatham v. LeRoy*, 2 Blatchf. 486, said:

“‘Formal changes are nothing—mere mechanical changes are nothing; all these may be outside of the description to be found in the patent, and yet the machine, after it has been thus changed in its construction, is still the machine of the patentee, because it contains his invention, the fruits of his mind, and embodies the discovery which he has brought into existence and put into practical operation.’”



We also venture to remind the court at this point of another rule of construction, and that is, that *a claim may be infringed even though the infringing device is not within the letter of the claim*. This rule was announced by the Supreme Court in the case of *Westinghouse v. Boyden*, 170 U. S. 568, where it was said:

“We have repeatedly held that a charge of infringement is sometimes made out, though the letter of the claims be avoided.”

And in support of that ruling the Supreme Court cited:

*Machine Co. v. Murphy*, 97 U. S. 120;

*Ives v. Hamilton*, 92 U. S. 426;

*Morey v. Lockwood*, 8 Wall. 230;

*Elizabeth v. Pavement Co.*, 97 U. S. 126;

*Sessions v. Romadka*, 145 U. S. 29; and

*Hoyt v. Horne*, 145 U. S. 302.

---

#### A CONCLUSIVE CITATION.

In conclusion we call the court's attention to an authority, which, in our judgment, is decisive. It is the Supreme Court case of *Ives v. Hamilton*, 92 U. S. 426, a leading case on the point under discussion. The patented device related to a saw-mill, and consisted, among other things, in pivoting the lower end of the saw to the pitman (connecting rod) *above* the crosshead. The defendant pivoted the lower end of his saw to the pitman

*below* the crosshead, thus avoiding the language of the claim. The court held this change of location to be inconsequential, and in rendering the decision Judge Bradley said:

“The attaching of the lower end of the saw to the pitman below the cross-head, instead of above it, and thereby getting the same movement as before by reversing the motion of the crank, is no change in principle. This is too obvious for discussion. The combination of the two things in the defendants’ mill—namely, the crooked guides above, and the connection of the saw with the pitman below at a point removed from its center of motion (both being calculated to give to the saw the precise rocking or vibratory motion desired)—is a close copy of the plaintiff’s invention; quite as close as is usually made by those who attempt to evade a patent whilst they seek to use the substance of the invention.”

It seems to us that this citation is decisive of the case at bar. We cannot conceive of two cases more closely analogous in principle. If Soule’s invention had been specific in character, merely an improvement on the prior devices, a different question would be presented. But his invention is basic and of pioneer character. He was the first in the art to provide a satisfactory device for tilting windows, whereby they could be brought to any desired position and there automatically held against ordinary strains without the intervention of separate locking mechanisms. It stands in the window art in the same favorable position that the saw patent stood in the sawing art described in the

case of *Ives v. Hamilton*. If it was an infringement for the defendant Ives to pivot his saw below the crosshead, notwithstanding the fact that Hamilton's patent called for a pivoting above the crosshead, it logically follows that it is an infringement for the defendant Hauser in the case at bar to pivot the upper end of his carrier arm to the sash, notwithstanding the fact that Soule's patent calls for a pivoting to the frame. And this must follow because this change of the pivot point produces no new result or new mode of operation. Such is the case here in a nutshell. It presents a definite and clearly defined issue based on an elementary proposition of patent law.

It would seem to be a useless task to analyze further cases in detail, and, therefore, we content ourselves with merely citing the following without further comment:

- Blake v. Eagle Works*, 3 Fed. Cas. 590;
- Dane v. Illinois Mfg. Co.*, 6 Fed. Cas. 1147;
- Gilbert & Barker v. Tirrell*, 10 Fed. Cas. 350;
- Gilbert & Barker v. Walworth*, 10 Fed. Cas. 352;
- King v. Maudelbaum*, 14 Fed. Cas. 536;
- Marsh v. Dodge*, 16 Fed. Cas. 805;
- Sewing Machine Co. v. Eames*, 6 Fed. Cas. 181;
- Belle v. Lucas*, 28 Fed. Rep. 371;
- Ames v. Bellaire*, 28 Fed. Rep. 360;
- Kirk v. DuBois*, 33 Fed. Rep. 252 (affirmed 158 U. S. 58);

*Adams v. Folger*, 120 Fed. Rep. 260 (263);  
*Indiana Mfg. Co. v. J. I. Case*, 154 Fed. Rep.  
 369;  
*Cazier v. Mackie-Lovejoy*, 138 Fed. Rep. 654;  
*Beech v. American Box Co.*, 63 Fed. Rep. 597;  
*King Axe Co. v. Hubbard*, 97 Fed. Rep. 795;  
*Calculagraph v. Wilson*, 132 Fed. Rep. 20;  
*Anchor Cap Co. v. Pritchard*, 232 Fed. Rep.  
 159.

---

### Conclusion.

The only theory on which we can account for the strange error of the trial court in rendering a decree of non-infringement is our belief that the lower court did not give sufficient consideration to the matter in hand. The trial judge was the Honorable Frank H. Rudkin, of Spokane, who had been specially called in to supply the place of Judge Van Fleet, who at the time of this trial was sitting in the District Court at New York. The case was tried in open court and was decided a short time after its submission. It was the last case on the calendar, and Judge Rudkin was anxious to return to Spokane where urgent business was requiring his attention. We believe that the necessity for his hurried departure prevented him from giving to this case the careful attention which should have been given. It is true that we filed a memorandum typewritten brief, but it contained only five pages relating to this patent. It was in purely

skeleton form and did not go into a close analysis of the matter. Possibly we were at fault in that behalf, but our excuse is that we considered the matter so plain and elementary that we did not deem it necessary to exert ourselves to the utmost. In that brief the only case we cited was that of *Metallic Extraction Co. v. Brown*, 104 Fed. 352. No other case herein was called to the attention of the court, and we believe that our misfortune in the lower court arose from not heeding the maxim "Beware of a plain case".

As we view the matter, this case is exceedingly simple and presents an elementary proposition of patent law. We insist that the decree is erroneous, palpably so, and should be reversed in the ends of substantial justice.

Dated, San Francisco,

September 26, 1917.

Respectfully submitted,

JOHN H. MILLER,

*Attorney for Appellant.*

